

## **REMARKS**

This paper is presented in response to the Office Action. By this paper, claims 1, 2, 6, and 16 are amended. Claims 21, 22, and 34-59 have been withdrawn by the Examiner as being directed to unelected species and/or inventions. As such, claims 1-20 and 23-33 remaining pending.

Reconsideration of the application is respectfully requested in view of the aforementioned amendments and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

### **I. General Considerations**

Applicant notes that the remarks and amendments presented herein have been made merely to clarify the claimed embodiments from elements purported by the Examiner to be taught by the cited references. Such remarks, or a lack of remarks, and amendments are not intended to constitute, and should not be construed as, an acquiescence, on the part of the Applicant: as to the purported teachings or prior art status of the cited references; as to the characterization of the cited references advanced by the Examiner; or as to any other assertions, allegations or characterizations made by the Examiner at any time in this case. Applicant reserves the right to challenge the purported teaching and prior art status of the cited references at any appropriate time.

In addition, the remarks herein do not constitute, nor are they intended to be, an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed herein are presented solely by way of example. Consistent with the foregoing, the discussion herein is not intended, and should not be construed, to prejudice or foreclose contemporaneous or future consideration, by the Applicant, of additional or alternative distinctions between the claims of the present application and any references cited by the Examiner, and/or the merits of additional or alternative arguments.

### **II. Objection to the Drawings**

The Examiner has objected to the drawings, alleging that certain claimed features are not shown in the drawings. Specifically, the Examiner asserts that "the supplemental channel circuitry includes an RF data sampler for sampling data from the first data stream to generate a set of sampled RF data and circuitry for including the sampled RF data in the second data stream" is not shown in the drawings. Applicant respectfully disagrees. Applicant refers the Examiner to the embodiment shown in Figure 16, which includes an RF Sampler 422 "for inserting a stream of samples of the RF data from the local subtree into the maintenance data stream." Page 32, lines 10-12. Inasmuch as the specification provides

clear support for the claimed feature, Applicant respectfully submits that the objection to the drawings should be withdrawn.

### **III. Rejection of Claims 13 and 29 under 35 U.S.C. § 112, Second Paragraph**

The Examiner has rejected claims 13 and 29 under 35 U.S.C. § 112, First Paragraph as failing to comply with the enablement requirement. Specifically, the Examiner asserts that claims 13 and 29 recite subject matter that was not sufficiently described in the specification as to enable one skilled in the art to make and/or use the invention. Applicant respectfully disagrees. For at least the reasons outlined below, Applicant respectfully submits that the Examiner has failed to establish that the specification would not enable one of skill in the art to practice the claimed invention without undue experimentation.

Specifically, Applicant notes at the outset that the Examiner has failed to properly state the test for enablement. Particularly, the test for enablement is not, contrary to the assertion of the Examiner, simply whether the claimed invention “was described sufficiently in the specification to enable one skilled in the art to make and use the invention.” Rather, it is well established that “The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. *In Re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).” *MPEP* § 2164.01. *Emphasis added.* In light of the foregoing, Applicant respectfully submits that the enablement test articulated by the Examiner is plainly inconsistent with longstanding U.S. Supreme Court and Federal Circuit precedent.

Applicant notes, moreover, that a determination that “undue experimentation” would have been needed to make and use the claimed invention is not easily reached. Particularly, the examination guidelines provide that “there are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any experimentation is ‘undue.’ These factors include, but are not limited to:

- (A) The breadth of the claims;
- (B) The nature of the invention;
- (C) The state of the prior art;
- (D) The level of one of ordinary skill;
- (E) The level of predictability in the art;
- (F) The amount of direction provided by the inventor;

- (G) The existence of working examples; and
- (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.”

*MPEP § 2164.01(a). Emphasis added.* In connection with the foregoing, the examination guidelines further provide that “It is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or more of the others. The examiner’s analysis must consider all the evidence related to each of these factors, and any conclusion of nonenablement must be based on the evidence as a whole. *Id. Emphasis added.*

As to the aforementioned factors, the examination guidelines explain that “The determination that ‘undue experimentation’ would have been needed to make and use the claimed invention is not a single, simple factual determination. Rather, it is a conclusion reached by weighing all the above noted factual considerations.” *Id. Emphasis added.*

As the foregoing makes clear, the Examiner has not only failed to properly state the test for enablement, but the Examiner has likewise failed to address the issue of undue experimentation as such is contemplated by the enablement test. Applicant respectfully submits that the aforementioned deficiencies are fatal to the rejection posed by the Examiner under 35 U.S.C. § 112, first paragraph.

Finally, inasmuch as the Examiner has provided no evidence or analysis whatsoever concerning the purported lack of enablement regarding claims 13 and 29, and has instead simply provided a conclusory statement that the claims fail to comply with the enablement requirement, it appears that the Examiner is relying on personal knowledge as a basis for rejecting claims 13 and 29. In view of the foregoing, and pursuant to 37 C.F.R. 1.104(d)(2), Applicant hereby respectfully requests an Examiner affidavit that: (i) specifically identifies any and all reference(s), other than those that have been specifically cited by the Examiner, upon which the rejection of claims 13 and 29 is based; and (ii) provides complete details concerning the reasoning and analysis of the Examiner concerning those references as those references are purported to apply to the rejection of claims 13 and 29.

For at least the reasons set forth above, Applicant respectfully submits that the rejection of claims 13 and 29 under 35 U.S.C. § 112, first paragraph should be withdrawn.

#### **IV. Rejection of Claims 1, 10, 14, 15, 19, 20, 23, 24, 26, 30, and 31 under 35 U.S.C. § 103**

Applicant respectfully notes at the outset that in order to establish a *prima facie* case of obviousness, it is the burden of the Examiner to demonstrate that three criteria are met: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one

of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP* § 2143.

The Examiner has rejected claims 1, 10, 14, 15, 19, 20, 23, 24, 26, 30, and 31 under 35 U.S.C. § 103(a) as being unpatentable over the admitted prior art (the “*APA*”) in view of U.S. Patent No. 5,684,799 to Bigham et al. (“*Bigham*”). Applicant respectfully disagrees however and submits that for at least the reasons set forth below, the rejection of claims 1, 10, 14, 15, 19, 20, 23, 24, 26, 30, and 31 should be withdrawn.

Of the rejected claims, claims 1, 15, 19, 23, and 31 are independent claims. Applicant notes however that in rejecting these independent claims, the Examiner refers *only to elements recited in claim 1* and has failed to specifically address a number of the elements recited in independent claims 15, 19, 23 and 31. Further discussion concerning this matter is set forth below.

**a. claims 1, 10, and 14**

As to claim 1, the Examiner has conceded that the *APA* does not include “supplemental channel circuitry for providing a second data stream; a multiplexer coupled to the RF signal receiver and the supplemental channel circuitry to receive the first data stream and second data stream and to output the combined data stream.” However, the Examiner has alleged that “it is well known in the art to have a supplemental circuitry for providing a second data stream and use a multiplexer coupled to the RF signal receiver and the supplemental channel circuitry to receive the first data stream and second data stream and to output a combined data stream.” In support of this allegation, the Examiner refers to *Bigham*, stating that *Bigham* discloses “a transmitter system (fig. 2) comprising a supplemental circuitry for providing a second data stream (fig. 2, for example, PAC data 136’) and a multiplexer (fig. 2, RF combiner 144) to output a combined data stream (fig. 2, output data stream to e/o converter 154).” Applicant notes that while the Examiner has referred to “fig. 2” of *Bigham*, it appears that it may be the case that the Examiner intended to refer instead to Figure 3 of *Bigham*.

As to the motivation for the purportedly obvious combination, the Examiner has alleged that it would have been obvious to modify the *APA* for the purpose of providing “... efficient transport of signaling traffic and interactive data.” Office Action, p. 5, *emphasis added*. Applicant notes at the outset however that “efficient transport” is a relative term whose definition is known only to the Examiner. For example, it is not at all apparent what reference point(s) the Examiner is using as a basis to assert and/or establish that such efficiency would necessarily be achieved.

Moreover, the Examiner has failed to establish that the *APA* device suffers from such shortcomings as could, or would, be remedied by use of the purported disclosure of *Bigham*. In the

absence of any evidence that the *APA* device is somehow deficient in terms of its “transport” (as stated by the Examiner), Applicant submits that the Examiner has failed to establish existence of the requisite motivation to make the purportedly obvious combination.

For at least the reasons set forth in the foregoing discussion, Applicant respectfully submits that the Examiner has failed to establish the existence of the requisite suggestion or motivation to make the purportedly obvious combination.

In addition, independent claim 1 has been amended herein to recite, among other things that the sample clock generator has “a first clock oscillator” and the return path transmitter includes “an output clock generator having a second clock oscillator for generating an output clock.” Support for this amendment can be found, for example, at least at original claim 2; page 7, lines 3-7; and Figure 4 of the application. In contrast, the Examiner has not established that the *APA* or *Bigham* teach, or even suggest, the aforementioned components in combination with the other limitations of claim 1.

In view of the foregoing, Applicant respectfully submits that the Examiner has failed to make out a *prima facie* case of obviousness with respect to claim 1, at least because the Examiner has not established the existence of a suggestion or motivation to modify the *APA* device in the purportedly obvious fashion, and because even if the references are combined in the purportedly obvious fashion, the resulting combination fails to include all the limitations of claim 1. Applicant thus respectfully submits that the rejection of claim 1, as well as the rejection of corresponding dependent claims 10 and 14, should be withdrawn.

**b. claims 15, 19, 20, 23, 24, 26, 30 and 31**

As noted above, in rejecting all of the independent claims 1, 15, 19, 23, and 31, the Examiner has addressed only the elements recited in claim 1. As to the other independent claims, the Examiner has failed to even assert, much less establish, that a proposed combination of the *APA* and *Bigham* teach or suggest all of the limitations of claims 15, 19, 23, and 31. For example, among other claim requirements,

- Claims 15 and 19 require, “first and second RF signal receivers”;
- Claim 19 further requires “a data port”;
- Claims 23 and 31 are method claims and recite various method steps.

However, the Examiner has not even asserted, much less established, that any combination of *APA/Bigham* discloses or suggest the aforementioned limitations in combination with the other limitations of the rejected independent claims. In fact, the Examiner has not asserted that any combination of *APA/Bigham* teaches any of the method steps recited in the rejected independent claims.

In view of the foregoing, Applicant respectfully submits that the Examiner has failed to make out a *prima facie* case of obviousness with respect to claims 15, 19, 23 or 31, at least because the Examiner

has not established that the purportedly obvious combination of the *APA* and *Bigham* teaches or suggests all of the limitations of claims 15, 19, 23 or 31. Applicant thus respectfully submits that the rejection of claims 15, 19, 23 and 31, as well as the rejection of corresponding dependent claims 20, 24, 26 and 30, should be withdrawn.

**V. Allowable Subject Matter**

The Examiner has indicated that claims 2-4, 5-9, 11-12, 16-18, 25, 27, 28, 32, and 33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. As discussed at IV. above, the rejection of claims 1, 15, 19, 23 and 31, from which claims 2-4, 5-9, 11-12, 16-18, 25, 27, 28, 32, and 33 variously depend, should be withdrawn for at least the reasons discussed above. As a result, claims 2-4, 5-9, 11-12, 16-18, 25, 27, 28, 32, and 33 are believed to be in condition for allowance.

**VI. Incorrect Attorney Docket No.**

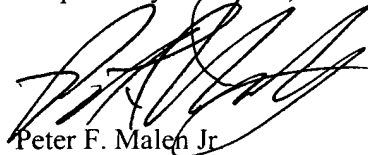
Applicant respectfully notes that the Office Action incorrectly references Attorney Docket No. "9775-0040-999." Pursuant to the Change of Attorney Docket Number filed in this case on September 24, 2003, the correct docket number for this case is 15436.253.24.1. Applicant thus respectfully requests that all applicable USPTO records be updated accordingly, and Applicant further requests that all further communications from the USPTO reference docket number 15436.253.24.1.

**CONCLUSION**

In view of the remarks submitted herein, Applicant respectfully submits that each of the pending claims 1-20 and 23-33 is in condition for allowance. Therefore, reconsideration of the rejections is requested and allowance of those claims is respectfully solicited. In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate the same with the undersigned attorney.

Dated this 28<sup>th</sup> day of April, 2006.

Respectfully submitted,



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